

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Luke K. Surazski et al.
Serial No.: 10/039,158
Filing Date: December 31, 2001
Group Art Unit: 2616
Confirmation No.: 9348
Examiner: Salman Ahmed
Title: **METHOD AND SYSTEM FOR MANAGING
ERRONEOUS ATTENUATION OF SIGNAL**

Mail Stop AF
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the rejected claims in the Application.

REMARKS

In the prosecution of the present Application, the PTO's rejections and assertions contain clear errors of law. Most notable of the legal errors present in the examination of the Application is a failure of the Final Office Action to establish a *prima facie* rejection of the claims. The Final Office Action rejected Independent Claims 1 under 35 U.S.C. §103(a) as allegedly being obvious over Davidson et al. ("*Davidson*") in view of U.S. Patent No. 4,689,506 to Pace et al. ("*Pace*"); Independent Claim 15 under 35 U.S.C. §103(a) as allegedly being obvious over *Davidson* in view of *Pace* and U.S. Patent No. 6,385,195 to Sicher et al. ("*Sicher*"); Independent Claims 9 and 23 under 35 U.S.C. §103(a) as allegedly being obvious over *Davidson* in view of *Pace* and U.S. Patent No. 5,933,495 to Oh ("*Oh*"); and Independent Claim 27 under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent Publication No. 2003/0078767, listing Nayak as inventor ("*Nayak*") in view of U.S. Patent No. 5,995,607 to Beyda et al. ("*Beyda*"). However, these rejections fail to meet the required *prima facie* standard for rejections for the reasons set forth below.

Section 103 Rejections Based on Davidson/Pace References

Independent Claim 1 is allowable because *Davidson* and *Pace*, even when combined, fail to disclose, expressly or inherently, "determining that noise is transmitted; in response to the determination, sending a notice of the transmitted noise; receiving the notice of transmitted noise; and in response to the notice, granting priority to an outgoing signal over the transmitted noise." (Emphasis added). The Final Office Action pointed to column 4, lines 32-33 of *Davidson* as an alleged disclosure of determining that noise is transmitted. *See* Final Office Action, page 3. This is incorrect. Column 4, lines 32-33 of *Davidson* clearly disclose detecting silence – not determining that noise is transmitted:

The method comprises the steps of detecting silence in a communications channel.

(Emphasis added). Furthermore, *Davidson* clearly defines silence as no noise at all:

However, if "true silence," meaning no noise at all, is transmitted across the network, the parties often misinterpret the absence of noise as an indication of a problem with the communication.

(*Davidson*, column 3, lines 45-48, emphasis added). At best, the combination of *Davidson* and *Pace* discloses detecting silence and attenuating an outgoing or incoming signal over the silence. However, it can not be disputed that detecting silence is not determining that noise is transmitted.

In response to similar arguments to those above, the Advisory Action of December 8, 2006 argued that “*Davidson* does teach transmitting silence or comfort noise.” Advisory Action, Page 3. However, the limitation is “determining that noise is transmitted” not “transmitting silence or comfort noise.” As indicated above, the combination of *Davidson* and *Pace* at best disclose detecting silence and attenuating an outgoing or incoming signal over the silence – not determining that noise is transmitted. The purpose of *Davidson*, if anything, is to detect absence of noise, not presence of noise. Accordingly, because the PTO has been unable to point to a reference, which discloses “determining that noise is transmitted,” a *prima facie* case has not been established with *Davidson* and *Pace*. For at least these reasons, Independent Claim 1 and its dependents should be allowed. Independent Claims 9, 15, and 23 and their dependents should be allowed for analogous reasons.

Section 103 Rejections Based on Nayak/Beyda References

Applicants previously pointed out that *Nayak* has an actual filing date (June 5, 2002) after the priority date of the Application (December 31, 2001). Therefore, Applicants previously submitted that in order for the PTO to utilize *Nayak* as a reference, the PTO must (1) establish the rejection based on the disclosure of *Nayak*, and (2) include a showing of support in a provisional application to which *Nayak* claims priority. See M.P.E.P. §706.02, Example 2 and M.P.E.P. §2136.03. In response, the PTO simply indicated that the “specification and drawing contain proper support.” See Advisory Action, Page 2. Applicants submit that such a statement is not a showing of support.

Notwithstanding the above, Independent Claim 27 is allowable because the proposed combination of *Nayak* and *Beyda* would render *Nayak* “unsatisfactory for its intended purpose.”¹ Clearly, one would not be motivated to combine references in a manner that would make the references unsatisfactory for their intended purpose. Accordingly, there is no suggestion or motivation to make the proposed combination.

¹ See MPEP 2143.01 (“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).
DAL01:935983.1

The Final Office Action acknowledged that *Nayak* does not disclose “receiving a status signal at the device indicating that the phone is operating as a speakerphone.” *See* Final Office Action, page 14. Therefore, the Final Office Action proposed combining features from *Beyda* to meet this limitation. Particularly, the Final Office Action indicated that *Beyda* teaches “[a] status signal indicat[ing] that the phone is operating as a speakerphone. *See id.* With this, the Final Office Action further stated that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine *Nayak* and *Beyda* because “[a]lthough an Internet telephony call provides a sufficient quality of service for a handset call, the additional ambient noise introduced in a speaker-phone call degrades the voice transmission quality to an unacceptable extent. As such *Beyda*’s scheme makes the voice quality better.” *See* Office Action, page 15 (emphasis added). However, this proposed combination renders *Nayak* inoperable for its intended purpose of “managing communication Impairments between an Internet Protocol phone (page 1 section 0009, voice telephony) and an Internet Protocol (page 1 section 0009, IP networks) device.” *See* Office Action, page 13 (emphasis added). For example, *Beyda* clearly states:

A call request which includes a request for a speaker-phone call or a conference call triggers the comparison processor to instruct a call router to route a call via the non-Internet telephony trunk . . . In an alternative embodiment, an in-session switch is performed from the Internet telephony trunk to a non-Internet telephony trunk connection in response to an attempted activation of the conference-call feature or the speaker-phone feature during an Internet telephony trunk connection.

See Beyda, Abstract (emphasis added). Therefore, assuming for the sake of argument that *Beyda* teaches a request for a speaker-phone, such a request would cause the call to be removed from an Internet Protocol routing, thereby rendering *Nayak* inoperable.

In response to similar arguments to those above, the Advisory Action of December 8, 2006 argued that the “test is what the combined teachings of the reference would have suggested to those of ordinary skill in the art.” Applicants do not necessarily disagree with this test; however, as previously indicated, “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). To this end, Applicants submit for the reasons indicated above that the PTO’s proposed combination renders *Nayak* inoperable for its intended purpose. Accordingly, because the PTO has been unable to provide an appropriate


motivation to combine *Nayak* and *Beyda*, a *prima facie* case has not been established with *Nayak* and *Beyda*. For at least these reasons, Independent Claim 27 and its dependents should be allowed.

CONCLUSION

As a *prima facie* rejection has not been established against Applicants' currently rejected claims, Applicants respectfully request a finding of allowance of all claims in the Application.

To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,
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